

REMARKS

The Applicants would like to thank the Examiner for the courtesy extended to their attorney, Kevin McDermott, during the telephone interview on October 27, 2005. Applicants' attorney requested clarification of the objections to the drawings.

Claims 19 and 21-36 are pending in the application. Applicants have amended the specification, but not the claims, by this Amendment. Applicants respond specifically to the issues raised in the Office Action mailed on August 9, 2005 as follows:

Specification

At the bottom of page 2 of the amendment filed on January 27, 2005, Applicants incorrectly identified the incorrect paragraph that was being amended. Applicants have corrected this error and amended the paragraph that begins at page 6, line 1 in the present amendment.

The Examiner has identified an inconsistency in the specification between "validation unit" at page 9, line 17 and "validation device" at page 9, line 23. Applicants have amended the paragraph beginning at page 9, line 10 so that the term "validation device" is used consistently in both instances.

Drawings

In the telephone interview on October 27, 2005, the objections to the drawings were discussed and the Examiner stated that the copies of the drawings containing Figures 6 and 7 which were scanned into the PTO database were unclear. The Examiner further stated that these

objections would be withdrawn if the Applicants resubmitted copies of the drawings for Figures 6 and 7. The Applicants are herewith resubmitting copies of the drawings for Figures 6 and 7, which were originally filed with the application.

Claim Rejections -- 35 USC § 112

Claims 27-36 have been rejected under 35 U.S.C. 112 as indefinite because the Examiner has found that the Applicants do not use the term "validation device" in accordance with its ordinary meaning and the specification does not clearly define the term "validation device." At page 4 of the Office Action, the Examiner states:

The term "validation device" in claims 27-36 is used by the claim to mean "writing a number to a document", while the accepted meaning is "to validate something."

Applicants respectfully disagree with the Examiner's finding and submit that the term is used in claims 27-36 in accordance with its ordinary meaning. In claim 27, the term "validation device" is used to describe a device which marks the document with information in order to provide an "authenticity certificate." Claim 27 reads in relevant part as follows:

a validation device comprising a transport device for receiving the document without a check number, a computing unit with an input keyboard, a recording means and an optical reader for mechanically reading off the identification, wherein the recording means, the input keyboard and the optical reader are connected to the computing unit, the computing unit is programmed for cryptographic operations with a first secret key for producing the check number by encryption of at least two parameters, the document number and the identification which is read off by the optical reader, and **the recording means writes the produced check number into the storage field** so that upon being put into circulation **the document is completed with the check number to provide an authenticity certificate.**

(Emphasis added.)

The Merriam-Webster OnLine dictionary defines the term “validate” as: “1 **a**: to make legally valid; **b**: to grant official sanction to by marking.” A copy of the page from the Merriam-Webster OnLine dictionary website is attached as Exhibit A.

The Examiner states that “the accepted meaning is ‘to validate something.’” In claim 27, the “validation device” makes the document “legally valid” by “marking” (or writing a number onto) the document to certify that it is authentic or “officially sanctioned.” This is clearly in accordance with the dictionary definition of the term “validate.” Therefore, the Applicants respectfully request that the Examiner withdraw the rejection and the finding that the term “validation device” is indefinite.

Claim Rejections -- 35 USC § 103

Claims 19 and 21-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,629,872 to Hällberg (“Hällberg”) in view of U.S. Patent No. 5,882,463 to Tompkin et al. (“Tompkin”).

The Examiner found at pages 4-5 of the Office Action that Hällberg discloses a method and apparatus for verifying personal identification information using a machine readable code or magnetic strip. In addition, the Examiner also found at page 5 of the Office Action that:

Hallberg does not explicitly disclose the identification is optically read out of optical-diffraction structures of the optical marking.

The Examiner contends that this deficiency in the Hällberg patent is found in the Tompkin patent. In describing the Tompkin patent, the Examiner found that:

Tompkin et al in an analogous art discloses a method of applying a security element to a substrate or a document, the security element comprises optical diffraction structures (col. 1, line 65 through column 2, line 18), the security element provides a security feature which is safeguarding the document from forgery, unauthorized copying, or from unauthorized alterations because of its optical effects which are produced by the diffraction structures (column 1, lines 5-28 and column 9, lines 5-45). **The document comprises several storage fields for readable individual codes relating to a person such as signatures, names, pictures, document number, etc. (figure 5).** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the magnetic strip or machine readable code of Hallberg to provide optical diffraction structures (column 1, line 65 through column 2, line 18), the security element provides a security feature which is safeguarding the document from forgery, unauthorized copying, or from unauthorized alterations because of its optical effects which are produced by the diffraction structures (column 1, lines 5-28 and column 9, lines 5-45) as taught by Tompkin et al.

(Emphasis added.)

Thus, the Examiner found that Tompkin et al disclose:

1. **“a method of applying a security element to a substrate or a document, the security element comprises optical diffraction structures”** -- However, a security element with “optical diffraction structures” is not the same as “an optical marking with a machine-readable identification” required by claims 19 and 27. There is no teaching that identification information can be read out of the optical-diffraction structures as required by the claims.

2. **“the security element provides a security feature which is safeguarding the document from forgery, unauthorized copying, or from unauthorized alterations because of its optical effects which are produced by the diffraction structures”** -- The security element taught by Tompkin et al. includes optical diffractive structures which are precisely positioned on a document to prevent tampering. The security elements cannot easily be

removed, the information changed and the security elements then replaced, because it is difficult to precisely reposition the diffractive structures of the elements on a document. However, these security elements provide security because of their optical effects (col. 2, lines 58-67), but do not have optical diffractive structures which contain machine-readable information.

3. **“The document comprises several storage fields for readable individual codes relating to a person such as signatures, names, pictures, document number, etc. (figure 5).”**

-- Tompkin et al. teach “several storage fields for readable individual codes,” but none of these storage fields is “an optical marking with a machine-readable identification” as required by claims 19 and 27. Nowhere in the Tompkin et al. patent are the optical diffraction structures described as containing “readable” information. Tompkin et al. merely teach optical diffraction structures that provide security due to their finely structured patterns. Col. 2, lines 2-3.

The Examiner found that, “Hallberg does not explicitly disclose the identification is optically read out of optical-diffraction structures of the optical marking,” but has not identified where this is taught by Tompkin et al. because Tompkin et al. **do not** teach optically reading out identification information from the optical-diffraction structures of the optical marking. Tompkin et al. merely teach a diffraction structure that is placed over readable information on a document.

Tompkin et al. disclose at col. 9, lines 16-32 that:

For further illustration FIG. 5 shows a pass 20 onto which a number 21 and the name 22 of a person are applied by printing. The pass or identity card 20 further includes a photograph 23 of the person and is provided with the signature 24 of

the person, in writing. To afford protection from forgery or imitation, the pass is provided with four security elements 25 through 28 which are in the form of a composite laminate 7 (FIG. 1) with optical diffraction structures 8. FIG. 5 shows only the contours of the security elements 25 through 28, but not their optical effects. **The security element 25 comprises fine lines 29 which form for example a guilloche pattern. The lines 29 cover over parts of the photograph 23 and part of the name 22** while in the intermediate spaces 30 the photograph 23 and the name 22 respectively are not covered and are thus visible. The security element 25 serves to prevent replacement of the photograph 23 and alterations to the name 22.

(Emphasis added.)

Thus, Tompkin et al. merely teach security elements with optical diffraction structures, which contain fine patterns. There is no teaching nor suggestion in Tompkin et al. that the optical security device contains optically readable information.

Page 7, lines 10-12 of the Office Action states:

Hallberg does not explicitly disclose the identification is optically read out of optical-diffraction structures of the optical marking. **Tompkin et al** discloses this limitation as discussed above in claim 19 and optical reader (column 10, lines 40-65).

Tompkin et al. do not teach that information can be “optically read out of optical diffraction structures of the optical marking.” At column 10, lines 40-65, Tompkin et al. teach a bar code wherein, “[t]he strips 31 and 32 contain diffraction structures 8 which diffract the light of a reading light beam of a reading device.” Col. 10, lines 46-48. However, the identification information is read from the bar codes, not from the diffraction structures. The diffraction structures are only intended to create a distinctive light diffraction pattern and are not intended to contain machine-readable information. Tompkin et al. specifically teach the diffraction

structures make it “possible to check the authenticity of the bar code 28 on the basis of the specific optical-diffraction properties of the diffraction structures 8.” Col. 10, lines 57-60. Thus, the diffraction structures are used as a device for checking the authenticity of the bar code and not as a device for storing information that can be optically read out. Tompkin et al. clearly teach that the information is being read out from the bar code, not from the diffraction structures.

Moreover, the “detect system 14” disclosed by Tompkin et al. is only used for positioning the security element at a specific location on the document. It is **not** used to optically read out information in the optical diffraction structures of the optical marking. Tompkin et al. state at col. 5, lines 16-22 that:

The device optionally includes a system 14 for **detecting the xy-position** of the substrate 9 so that the position of the laser beam 12 can be exactly oriented to the xy-position of the substrate 9. That permits the security element to be applied to the substrate 9 in accurate register relationship. The laser light source 13 includes a laser and also an optical system which is necessary for beam guidance and beam focusing.

(Emphasis added.)

Thus, Tompkin et al. neither teach nor suggest that the “detect system” which they disclose is intended for, or capable of, optically reading machine-readable information from optical diffraction structures.

Claims 19 and 27 are the only independent claims pending and both claims require, “an optical marking with a machine-readable identification” and both claims require that, “the identification is optically read out of optical-diffraction structures of the optical marking.”

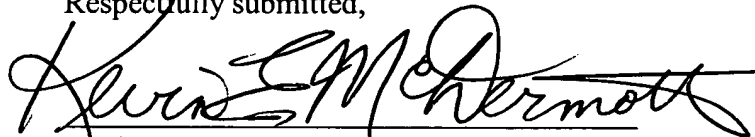
Tompkin et al. neither teach nor suggest that the optical diffraction structures disclosed in their

patent contain machine readable information, nor do they teach a device for reading information from an optical diffraction structure. Therefore, Tompkin et al. fail to teach the deficiency in the Hällberg patent identified by the Examiner. Specifically, Tompkin et al. do not teach that “the identification is optically read out of optical-diffraction structures of the optical marking.”

Conclusion

A combination of the Hällberg patent and the Tompkin et al. patent fails to teach optical diffraction structures which contain machine-readable information as required by the claims of the present application. Therefore, the Applicants submit that the claims are not obvious and respectfully request that the Examiner withdraw the rejections based on these references and allow the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kevin E. McDermott", written over a horizontal line.

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One entry found for **validate**.

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validate

Main Entry: **val-i-date**

Pronunciation: 'va-l&-"dAt

Function: *transitive verb*Inflected Form(s): **-dat-ed; -dat-ing**

1 a : to make legally valid **b** : to grant official sanction to by marking **c** : to confirm the validity of (an election); *also* : to declare (a person) elected

2 : to support or corroborate on a sound or authoritative basis <experiments designed to *validate* the hypothesis>

synonym see CONFIRMFor **More Information on "validate"** go to Britannica.comGet the Top 10 Search Results for "validate"

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EXHIBIT A